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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/981,915      | 10/16/2001  | Luc Desnoyers        | GNE.2630PIC12       | 8309             |

7590

10/30/2006

Ginger R Dreger  
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275 Middlefield Road  
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EXAMINER

BLANCHARD, DAVID J

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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1643

DATE MAILED: 10/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/981,915

Applicant(s)

ASHKENAZI ET AL.

Examiner

David J. Blanchard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 61-65, 68-70, 74 and 75 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☒ Claim(s) 63-65, 68 and 74-75 is/are allowed.  
6) ☒ Claim(s) 61, 62, 69 and 70 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☒ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. see attached.  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

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### **DETAILED ACTION**

1. Claims 1-60, 66-67 and 71-73 are cancelled.  
Claims 61-62, 64-65, 69 and 74-75 have been amended.
2. Claims 61-65, 68-70 and 74-75 are pending and under examination
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Inventorship***

4. In view of the papers filed 03 August 2006, the inventorship in this nonprovisional application has been changed by the deletion of inventors Avi J. Ashkenazi, Kevin P. Baker, David Botstein, Dan L. Eaton, Napoleone Ferrara, Sherman Fong, Hanspeter Gerber, Mary E. Gerritsen, J. Christopher Grimaldi, Kenneth J. Hillan, Ivar J. Kljavin, Sophia S. Kuo, Mary A. Napier, James Pan, Nicholas F. Paoni, Margaret Ann Roy, David L. Shelton, Timothy A. Stewart, Daniel Tumas and P. Mickey Williams. Therefore, Luc Desnoyers, Ellen Filvaroff, Wei-Qiang Gao, Audrey Goddard, Paul J. Godowski, Austin Gurney and William I Wood remain named inventors in the present application.

The application will be forwarded to the Office of Initial Patent Examination (OIPE) for issuance of a corrected filing receipt, and correction of Office records to reflect the inventorship as corrected.

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***Rejections Withdrawn***

5. The rejection of claims 61-62, 69-70 and 74-75 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in the recitation "An isolated polypeptide...comprising a polypeptide" is withdrawn upon further consideration and in view of applicants arguments.

***Response to Arguments***

***Priority***

The following is reiterated for applicants' convenience. The patentable utility for the subject matter defined in claims 63-65, 68 and 74-75 is based on the proliferation of rat utricular supporting cells assay (Example 116 at page 277 of WO 99/46281), which was first disclosed in PCT/US99/05028 (WO 99/46281), filed 3/8/1999 and patentable utility for the subject matter defined in claims 61-62, 69-70 is based on the chondrocyte re-differentiation assay (Example 126 at page 359) which was first disclosed in PCT/US00/04341 (WO 00/53756), filed 2/18/2000. Therefore, claims 63-65, 68 and 74-75 are granted priority to 3/8/1999 and claims 61-62 and 69-70 (as dependent upon claim 61) are granted priority to 2/18/2000.

6. The rejection of claims 61-62 and 69-70 under 35 U.S.C. 102(a) as being anticipated by Fukushima et al [a] (WO 99/58668, published 11/18/1999) as evidenced

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by English equivalent Fukushima et al [b] (U.S. Patent 6,664,383 B1, cited on PTO-892 mailed 6/20/05) is maintained.

The response filed 8/3/2006 states that the present application claims priority to US Provisional Application Serial No. 60/079,294, filed on March 25, 1998, (Exhibit A) which provides the nucleic acid and amino acid sequences of the PRO337 polypeptide and discloses that the full length PRO337 polypeptide (SEQ ID NO:523) has significant homology to rat neurotrimin. Applicant also argues that based on the holding in *In re Stempel* and *In re Moore*, which states that in order to effectively remove a cited reference as prior art, an applicant need only show that portion of his or her claimed invention that appears in the cited reference. Applicant submits that since Fukushima et al only disclose a polypeptide sequence, its encoding nucleic acid sequence, without any disclosure to support utility, Applicants simply need to show possession of the polypeptide sequence and its encoding polynucleotide sequence as well as a sequence homology as disclosed in Fukushima et al in order to remove the reference as prior art under 35 U.S.C. 102. This has been fully considered but is not found persuasive. Unlike in *In re Stempel* and *In re Moore*, the rejected claims rely on the chondrocyte re-differentiation assay (Example 126 at pg. 359 of the spec.) for utility of the claimed polypeptides, i.e., "wherein the polypeptide induces chondrocyte re-differentiation" (claims 61-62). Since prior applications 09/380,138, PCT/US99/05028 and 60/079,294 do not disclose the chondrocyte re-differentiation assay upon which applicant relies for utility of the instantly claimed polypeptides, the filing date for the purpose of art

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rejections for claims 61-62 and 69-70 (as dependent upon claim 61) is deemed to be that of PCT/US00/04341 (WO 00/53756), i.e., 18 February 2000.

Applicant is reminded that under 35 U.S.C. 120, a claim in a U.S. application is entitled to the benefit of the filing date of an earlier filed U.S. application if the subject matter of the claim is disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the earlier filed application. See, e.g., *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 47 USPQ2d 1829 (Fed. Cir. 1998); *In re Scheiber*, 587 F.2d 59, 199 USPQ 782 (CCPA 1978). A claim in a subsequently filed application that relies on a combination of prior applications may not be entitled to the benefit of an earlier filing date under 35 U.S.C. 120 since 35 U.S.C. 120 requires that the earlier filed application contain a disclosure which complies with 35 U.S.C. 112, first paragraph for each claim in the subsequently filed application. *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564, 42 USPQ2d 1674, 1677 (Fed. Cir. 1997). A deficiency under 35 U.S.C. 101 also creates a deficiency under 35 U.S.C. 112, first paragraph. See *In re Brana*, 51 F.3d 1560, 34 USPQ2d 1436 (Fed. Cir. 1995).

For these reasons and those already of record, the rejection of claims 61-62 and 69-70 under 35 U.S.C. 102(a) as anticipated by Fukushima et al [a] as evidenced by Fukushima et al [b] is maintained.

### **Conclusion**

7. Claims 63-65, 68 and 74-75 are free of the prior art. It is noted that claims 74-75 are granted priority to PCT/US99/05028, i.e., 3/8/1999 (see "Priority" above).

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8. It is also noted that Applicant has successfully completed the requirements and supplied the necessary assurances for the biological deposit of DNA43316-1237 (ATCC 209487) in the response filed 13 September 2005.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Blanchard whose telephone number is (571) 272-0827. The examiner can normally be reached at Monday through Friday from 8:00 AM to 6:00 PM, with alternate Fridays off. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Helms, can be reached at (571) 272-0832. The official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the patent Application Information Retrieval (PAIR) system. Status information for

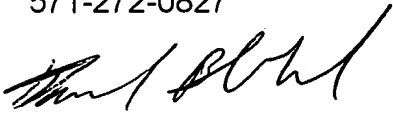
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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully,  
David J. Blanchard  
571-272-0827

A handwritten signature in black ink, appearing to read "David J. Blanchard", is written below the typed name.